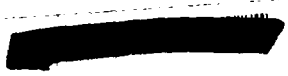


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Application of)	
)	
Malco Products, Inc.)	
)	Doritt Carroll
Serial No. 76/260,899)	Examining Attorney
)	
Filed: May 23, 2001)	Law Office 115
)	
For: "STOP" and Design)	



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APPELLANT'S REPLY BRIEF

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Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

In responding to the Examining Attorney's Appeal Brief, Appellant herein focuses mainly upon the particular positions taken by the Examining Attorney in her Appeal Brief. Of course, the arguments in defense of Appellant's right to have the subject mark registered are not limited to those arguments here presented. Rather, in addition to the arguments presented here, Appellant also relies upon every argument that Appellant has made during the prosecution of the subject mark.

The Examining Attorney has refused registration on the ground that Appellant's mark is confusingly similar to U.S. Registration Nos. 1,435,345 and 1,452,907. Particularly, the Examining Attorney maintains that confusion is likely

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(1) because the marks themselves are similar, and (2) Appellant's and Registrant's goods are related.

Despite Appellant's highly logical and rational arguments to the contrary, the Examining Attorney has maintained that the marks at issue are similar. Particularly, the Examining Attorney feels that the marks are dominated by the word "STOP," and has given greater weight to this dominate feature than to other highly relevant features of the mark in determining and concluding that there is a likelihood of confusion. In response to Appellant's arguments that "ONE STOP" has a significantly different meaning from "STOP," and that, therefore, confusion is not likely between Appellant's and Registrant's marks, the Examining Attorney accuses Appellant of making "merely a side-by-side comparison" rather than focusing upon "the recollection of the average purchaser who normally retaining a general rather than specific impression of trademarks." Nothing could be further from the truth. Appellant has consistently focused upon the recollection of the average purchaser, particularly, the recollection of an average purchaser encountering the terms "ONE STOP" in the marketplace. That is, the average purchaser encountering the terms "ONE STOP" would be left with the impression that multiple needs can be met by the particular service or product provider that is employing the term "ONE STOP" in connection with its goods or services. Indeed, regarding goods and services in the automobile industry, "ONE STOP" is regularly employed for conveying such an understanding to the consuming public. For example, it is not at all uncommon for

oil change service shops to advertise that they are a "ONE STOP" shop for your automobile needs. Similarly, with Registrant's goods, the general impression left with the average purchaser is that Registrant may be sought out as a "ONE STOP" shop for automotive electrical components and/or automotive electronic services. The Examining Attorney's refusal to grant any significance to the term "ONE" as employed with "STOP," while strengthening the Examining Attorney's position, is simply not practical.

Appellant's mark, in distinction, contains only the term "STOP," and, in relation to Appellant's goods, this distinction over Registrant's mark is significant. Appellant's goods are far removed from Registrant's goods, and an average purchaser would not be likely to confuse the source of Appellant's goods with the goods identified by Registrant's ONE STOP mark, and vice versa. While it is true that the goods identified in Appellant's application are employed with automobiles and that Registrant's goods are also employed with automobiles, there is simply no reason to conclude that consumers would assume that the source of automobile electrical components and automobile fluids might be the same. This is especially true in light of the suggestive nature of both Appellant's and Registrant's marks, as will be explained below.

The Examining Attorney has cited to the case of *In re Sun Supermarkets, Inc.*, 228 U.S.P.Q. 693 (TTAB 1986). Therein, the TTAB found that a likelihood of confusion existed between "SUN SUPERMARKETS" and two cited registrations for

"SUNSHINE" and "SUNRISE," wherein every mark was directed toward grocery store services. The Board found that "while there are particular differences in the designs, they are strikingly similar in overall impression," and that, in word of mouth recommendations, the similarities between the marks and the designs would be emphasized, rather than the differences. The Examining Attorney holds that the same comments could be made here, and, thus, cites to the this case as support for her position.

Appellant must respectfully disagree. The case of *In re Sun Supermarkets* is so different from the present situation as to be almost entirely inapplicable. Particularly, in *Sun Supermarkets* all of the marks at issue were for grocery store services, and were held to be "arbitrary in respect of retail grocery store services." See *Sun Supermarkets*, 228 U.S.P.Q. at 695. Additionally, the Court noted that the Registrant of SUNRISE and SUNSHINE should be free to use the generic term "supermarkets" in association with its marks, and that, therefore, the additional term "supermarkets" in the Appellant's mark did not alleviate consumer confusion.

Here, the marks at issue are not arbitrary with respect to the goods with which they are employed. Rather, they are somewhat suggestive. That is, Registrant's ONE STOP marks suggest, as Appellant has consistently argued, that Registrant might be relied upon as a one stop shop for a consumer's electrical automobile component needs, while Appellant's STOP mark suggests to consumers that Appellant's goods might be employed to "stop" something undesirable from

happening to a consumer's automobile. For example, Appellant's products sold under the "STOP" mark might stop or prevent corrosion, wear, etc. in one's automobile. Due to the somewhat suggestive nature of both Registrant's and Appellant's marks, the average purchaser would not, as the Examining Attorney has done, simply disregard the term "ONE" that comes before the term "STOP" in Registrant's marks. To disregard "ONE" is to disregard the actual impression that is likely left in the average consumer's mind upon observing "ONE STOP" and the goods with which it is employed. Thus, the finding in *Sun Supermarkets* that the marks therein were "strikingly similar in overall impression" is not proper in the present appeal inasmuch as Registrant's and Appellant's marks are somewhat suggestive and therefore leave a stronger impression upon the average purchaser, an impression that supports a conclusion that confusion is not likely. Similarly, the holding in *Sun Supermarkets* regarding word of mouth recommendations is not applicable to the present case. It is simply not likely that a consumer familiar with Registrant's electrical goods would disregard the term "one" in recommending Registrant's goods/services to another.

To summarize, the average purchaser, retaining a general rather than specific impression of trademarks, would attribute much significance to the term "one" as employed together with the term "stop" in Registrant's marks, especially due to the fact that the Registrant's mark is somewhat suggestive of its goods (as a "one stop" shop for automotive electrical components), and this suggestive nature would not be

lost on the average purchaser. Additionally, Appellant's "STOP" mark is somewhat suggestive of Appellant's goods, and, therefore, the average purchaser would have a more specific impression of Appellant's trademark as it is employed in association with the goods listed in Appellant's application. A side-by-side comparison is certainly not necessary for consumer's to readily distinguish between Appellant's "STOP" goods and Registrant's "ONE STOP" goods, as the differences between the two marks, especially as based upon the meaning and impression left by the marks in association with the goods with which they are employed, are much more apparent that the Examining Attorney here holds.

In supporting a likelihood of confusion conclusion, the Examining Attorney also holds that the parties' goods are related. In support of this refusal, the Examining Attorney has shown copies of registrations wherein car parts and fluids for use in cars are sold under a single trademark. The Examining Attorney then contends that consumers would be familiar with this practice and would naturally assume that automobile replacement parts and fluids, **both sold under a distinctive "STOP & stop sign design"** trademark, are related (emphasis added).

In responding to this argument, Appellant notes that the Examining Attorney improperly disregards the term "one" as employed with Registrant's goods. Thus, Appellant places emphasis upon the Examining Attorney's statement that both marks are "sold under a distinctive 'STOP & stop sign design' trademark." The truth is, the automobile electrical components and replacement parts offered by Registrant are

offered under a somewhat suggestive "ONE STOP & stop sign design" trademark, while Appellant's automobile fluids and cleaning preparations are sold under a somewhat suggestive "STOP & stop sign design" trademark. Again, the ONE cannot be disregarded, no matter how much the refusal to treat ONE with significance might help the Examining Attorney's position. As mentioned above, these marks create a different overall commercial impression in the recollection of the average purchaser, without the need for a side-by-side comparison. Even if consumers were familiar with the practices of a few large corporations that offer both automotive parts and fluids for use in automobiles under the same trademark, such a conclusion addresses neither the distinctions between the marks at issue nor the overall commercial impression that they leave with the average consumer.

Not only does the Examining Attorney improperly disregard the term "one" in Registrant's marks, but the Examining Attorney also incorrectly concludes that Registrant's goods are "very broad" and encompass "all goods/services of the type described, including those in Appellant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers." Quite simply, it is hard to see how the "automotive electrical switches, automotive electrical connectors, automotive electrical assembly units, automotive speaker wire, automotive electrical sockets, automotive fusible links, automotive electrical terminals, automotive electrical wiring units, automotive electrical primary wire, automotive electrical pig tails in the nature of connectors, and automotive electrical

harnesses" (Registration No. 1,435,345); and "screws, clamps, lugs, and rings" and "electrical equipment and parts, namely solderless connectors, test clips, insulated clips, charging clips, connectors, wire joints, line tabs, wire splices, grommets, cable ties, box connectors, circuit breakers and testers, ground clips, conduit fittings, wire; preinsulated terminals, splices, spades and disconnects for wire gages, switches and switch panels" (Registration No. 1,452,907) even come close to encompassing "power steering fluid, chemical additives for fuel and diesel fuel treatment, fuel injection cleaner chemical additive, octane booster fuel chemical additive, carburetor and choke cleaning preparations, automobile wax, cleaning preparation for automobile brakes and parts therefore, and automatic transmission fluid" (Appellant's application Serial No. 76/260,899). Clearly, Appellant's and Registrant's goods do not overlap. Registrant provides electrical components for automobiles, and is considered, or at least considers itself to be, a "one stop" shop for such components, while Appellant offers fluids for use in automobiles, fluids which might be used to "stop" or "prevent" certain deleterious effects in one's automobile. These marks are highly distinguishable, especially in light of the somewhat suggestive quality that they have with respect to their distinguishable goods.

In distinguishing Registrant's and Appellant's goods in a prior response, Appellant asked the Board to take "judicial notice" of the fact that ordinary consumers typically do not purchase or install automotive electrical equipment. Appellant apologizes for having used such a legally significant term as "judicial notice."

Certainly, it is common in trademark prosecution practice to consider the sophistication of the ordinary consumers of the goods within any cited registration. This is all that Appellant was asking the Board to do. That is, Appellant simply asks the Board to use as supportive evidence the fact that most car owners take their car to a mechanic or other service provider to have electrical work done on their cars. Such work is not very simple and is not typically handled by the layman. Thus, consumers interested in Registrant's goods are likely to be more sophisticated and discriminating than your average spur-of-the-moment purchaser or an average purchaser of common, every day goods. Additionally, electrical components for automobiles are important components of an automobile and, as such, will be purchased with due consideration as to the source from which they originate. Thus, the nature of registrant's goods makes confusion between Registrant's marks and Appellant's mark unlikely.


Finally, the Examining Attorney has acknowledged that the subject marks have existed side-by-side for several years without any known instances of actual confusion. However, the Examining Attorney concludes that confusion is likely regardless of this fact. While it is true that the presence or absence of actual confusion is only one of the *duPont* factors, and that the Examining Attorney may find a likelihood of confusion even in the absence of actual confusion, the fact that actual confusion has not occurred leads one to a conclusion that Appellant's position with respect to likelihood of confusion is the more practical and logical position. That is, the Appellant's arguments respecting the different commercial impressions

created by the subject marks and the differences in the goods with which those marks are related more accurately reflect the interaction of the subject marks in the marketplace.

In light of the foregoing, the decision of the Examining Attorney to refuse registration of the subject mark should be reversed, and the application to register the mark "STOP" & design should pass to publication.

Enclosed is a check in the amount of \$160.00 for payment of the filing fee. The Commissioner is hereby authorized to charge any additional filing fees required or credit any overpayment to deposit account 18-0987.

Respectfully submitted,



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CERTIFICATE UNDER 37 C.F.R. 1.10

I hereby certify that the foregoing Applicant's Reply Brief submitted herewith for Malco Products, Inc., Application Serial No. 76/260,899, filed May 23, 2001, for "STOP," is being deposited with the United States Postal Service in an envelope addressed to: Box TTAB Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, this 17th day of March, 2003.



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